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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,368	02/12/2001	John E. Cronin	ipCG-508	4217

7590 02/17/2004  
ip Capital Group, Inc.  
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EXAMINER

MOONEYHAM, JANICE A

ART UNIT PAPER NUMBER

3629

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/781,368

Applicant(s)

CRONIN, JOHN E.

Examiner

Jan Mooneyham

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ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is in response to the applicant's communication filed on February 12, 2001. Claims 1-27 are currently pending in this application.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on July 2, 2001 is being considered by the examiner.

#### ***Oath/Declaration***

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The oath or declaration received on May 14, 2001 has listed two inventors. This is different from other information provided as to the inventor of this invention.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The terms

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“mess statements, data statements, and problem statements, seed” in claims 1-5, 12, 17 and 18 are indefinite because the specification does not clearly redefine the term.

5. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 17 contain the term “elements relating to the problem statements, mess statements and/or data statements.” It is unclear what the term “elements” means.

What are the limitations of problem-element-solution combinations?

What are the solutions to the limitations?

In claims 5 –11 and 19-21, the applicant states that the elements are randomly generated or are conceived by users as the result of a stimulus. What is the stimulus?

How are the elements randomly generated?

How are the elements conceived using visual, tactile or olfactory stimulus?

How doe a solution become conceived using one element and a problem statement as a creative stimulus?

How is the solution stored in a manner which indicates its relationship to a problem and an element.

In Claim 12, what is meant by a complete invention? What is meant by a seed of an invention? What are all limitation of the seed of an invention and what are all solutions to the limitations?

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatton (US Patent No. 6,101,490) (hereinafter referred to as Hatton).

Hatton discloses a system and method for creating new ideas and solving problems which provides a computer processor programmed to accept input and provide output, requesting and accepting input comprising data, inputting data (Fig. 7, receiving input statement), aggregating and storing the data (Fig. 7 – add new entry to plant data base) and providing out displaying the aggregated data (Fig. 7 – display result).

Hatton does not explicitly show the data to be a mess statement, a data statement relating to the mess statement, problem statements relating to the data statements, elements relating to the problem statements, mess statements and/or data statements, solutions to the problem statements, limitations of problem-element-solution combinations, solutions to the limitations and elements conceived using visual, tactile or olfactory stimulus, or how the solutions are conceived. However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited or the claimed structure. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re*

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*Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983; *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person or ordinary skill in the art to use data having any type of content because such data does not functionally relate to the steps or the structure of the method or apparatus claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

The fact that the applicant is claiming a system and method for facilitating conception of inventions verses creating new ideas and solving problems adds little to the claimed structure or acts since this language is in the preamble and also since this language is also directed to the intended use of the system and method.

A computer processor is inherently a component of a server.

The fact that the computers are linked via a network selected from a group consisting of a local area network, the Internet or Intranet, or that there are one or more participant computers remotely located is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate any of these limitations into the system and method of Hatton since this is old and well known technology and would have been common knowledge to one having ordinary skill in the art.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Thakur discloses a method and system for acquiring, evaluating and marketing innovation.

Gakidis et al discloses a system and method for routing ideas among submitters and evaluations.

Grainger et al discloses a method and system for managing information disclosure statements.

Waters discloses a system and method for obtaining new ideas and idea generation between multiple sources.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM

**JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600**